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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/743,455

12/23/2003

Jean De Rigal

118111

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25944

7590

06/29/2007

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EXAMINER

KRASS, FREDERICK F

ART UNIT

PAPER NUMBER

1614

MAIL DATE

DELIVERY MODE

06/29/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

Application No.

10/743,455

Applicant(s)

DE RIGAL ET AL.

Examiner

Frederick Krass

Art Unit

1614

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 10 May 2007.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-38 is/are pending in the application.
- 4a) Of the above claim(s) 16-31 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-15 and 32-38 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 September 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
  - 2) ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date A, B & C.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_.

### **Restriction Requirement**

Applicant's election with traverse of Group I in the reply filed on 05/10/07 is acknowledged. The traversal is on the ground(s) that the subject matter of all the claims is sufficiently related such that examination could be conducted without serious burden on the examiner. This is not found persuasive because this is merely a conclusion unsupported by facts. The examiner has already set forth in the previous Office action and in detail the reasons an undue burden is believed to exist, complete with supporting rationale and facts.

The requirement is still deemed proper and is therefore made FINAL.

Claims 16-31 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to nonelected inventions, there being no allowable generic or linking claim.

### **Claim Informalities**

Claims 14 and 15, third line of each claim, in each instance the word --- and --- should be inserted immediately before the final occurrence of "within" on the line.

### **Indefiniteness Rejection**

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-15 and 34-38 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

1) Claims 1 and 2, first line of each claim, in each instance the modifying function of the term “-type” is unclear, given that the specification defines the term “foundation-type” as being nothing more than cosmetic.

In order to obviate this ground of rejection, the examiner recommends amending the first line of claims 1 and 2 to recite “A foundation cosmetic composition comprising...”

2) Claims 1-15 and 34-38 are incomplete insofar as the variables used therein are not defined, i.e. the symbols “ $1/\Delta E$ ”, “C”, “h”, “a”, etc.

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### **Anticipation Rejection**

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

1) Claims 32 and 33 are rejected under 35 U.S.C. 102(b) as being anticipated by French Patent 2 178 441 (full English language translation).

The primary reference discloses a device enabling one to select the proper makeup hue for application to a given part of the face so as to provide the optimum overall aesthetic effect. See, e.g., the first and last 3 paragraphs of page 2 of the translation. Where the subject had “dark” skin (which would include relatively darker areas on the face), this would inherently involve selecting cosmetic shades having a lightening effect as required by instant claim 33.

2) Claims 32 and 33 are rejected under 35 U.S.C. 102(b) as being anticipated by JP 2000-212036 (machine translation).

The prior art discloses methods for selecting the proper makeup hue best suited to lightening dark skin, based on state of melatonin and irregular color of skin as indices. See, e.g., paragraph 0003.

### Obviousness Rejection

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

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1) Claims 1-15 and 34-38 are rejected under 35 U.S.C. 103(a) as being unpatentable over French Patent 2 178 441 (full English language translation) in view of MacFarlane et al (USP 5,313,267).

The primary reference is discussed supra and differs from the instant claims insofar as it does not specify, *ipsissima verba*, selection of cosmetics based specifically on skin color (necessary to arrive at the particular lightness values recited by instant claims 1-15 and 34-38).

The secondary reference provides methods for personal color characterization using skin color as the exclusive determining factor. See column 2, lines 25-68. By varying the amount and type of coloring agent present in various personal accessories, including makeup foundation, the color of the accessories can be adjusted for optimal compatibility with skin color. See column 4, lines 34-48; see also column 16, lines 34-68. The secondary reference differs from the instant claims insofar as it does not specify selection based on differences in shading within different parts of the face (necessary to arrive at the particular levels of homogenization and covering power recited by instant claims 1-15 and 34-38).

It would have been obvious to have formulated cosmetics having an optimal combination of physical characteristics (homogenization power, covering power, etc.) for a given shade selected by the device of the primary reference, based on color characterization using skin color as the exclusive determining factor as taught by the secondary reference.

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2) Claims 1-15 and 34-38 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP 2000-212036 (machine translation).

The prior art is discussed supra differs from the instant claims insofar as it does not specify cosmetics having the particular combination of physical characteristics (homogenization and covering power) required by instant claims 1-15 and 34-38. Generally, however, it is prima facie obvious to determine workable or optimal values within a prior art disclosure through the application of routine experimentation. See In re Aller, 105 USPQ 233, 235 (CCPA 1955); In re Boesch, 205 USPQ 215 (CCPA 1980); and In re Peterson, 65 USPQ2d 1379 (Fed. Cir. 2003). Accordingly, it would have been obvious to one of ordinary skill in the art of cosmetic formulation to have determined the optimal combinations of properties, including homogenization and covering power, necessary to provide optimal aesthetics when applied to individuals having dark skin as determined by the methods of JP 2000-212036.

### **Correspondence**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Frederick Krass whose telephone number is (571) 272-0580. The examiner can normally be reached at (571) 272-0580 on Monday through Friday from 9:30AM to 6:00PM.



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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ardin Marschel, can be reached at (571) 272-0718. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Frederick Krass  
Primary Examiner  
Art Unit 1614

